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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

in application of

Shahram MIHAN et al.

Serial No. **10/522,574**

Filed **November 1, 2005**

For **MONOCYCLOPENTADIENYL COMPLEX**

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) Art Unit 1796
)
) Examiner C. C. Lu
)
)

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL LETTER


Submitted herewith for filing in the U.S. Patent and Trademark Office are the following:

- ☒ Postcard
- ☒ Response to Restriction Requirement (5 pages)

Respectfully submitted,

SHAHRAM MIHAN ET AL.

By


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Date: **February 13, 2008**



Attorney Docket No. LU 6046

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Shahram MIHAN, et al.

Serial No.: 10/522,574

Group Art Unit: 1796

Filed: November 1, 2005

Examiner: C.C. LU

For: **MONOCYCLOPENTADIENYL COMPLEX**

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action dated January 14, 2008. The one month shortened statutory period for response was set to expire on February 14, 2008. Thus, this response is timely filed.

SUMMARY OF RESTRICTION AND ELECTION REQUIREMENT

The Official Action states the following:

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-6, drawn to a metallocene complex.

Group II, claim(s) 7-8, drawn to metallocene catalyst composition.

Group III, claim(s) 10, drawn to a polymerization process.

Group IV, claim(s) 11, drawn to a process of a metallocene precursor.

Group V, claim(s) 12, drawn to process of making a ligand compound.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: (i) Groups I, Groups II&III, Groups IV, and Groups V do not share a common technical feature; (ii) the metallocene catalyst common feature share between Group II and Group III is disclosed in Ewen et al (WO 98/22486). As the recited catalyst complex does not make a contribution over the prior art, i.e. the special technical feature(s) is anticipated by or obvious in view of the prior art, unity of invention is lacking and restriction is appropriate.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

various metallocene complexes as disclosed in claim 4 and 5.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP §809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

The metallocene complexes species read on claims 1-8 and 10

The following claim(s) are generic: none.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Pursuant to PCT Rule 13.2 and PCT Administrative Instructions, Annex B, Part 1(f)(1)(B)(2), the species are not art recognized equivalents.

PROVISIONAL ELECTION

Applicant provisionally elects Group I, drawn to metallocene complexes. Applicant respectfully believes claims 1-6 are readable on the elected invention.

Additionally, Applicant respectfully elects (3-(2-pyridylethyl)indenyl)chromium dichloride in response to the Examiner's species election requirement.

TRAVERSAL

Applicant respectfully traverses the Examiner's restriction

requirement.

In particular, Applicant traverses the Examiner's contention that pending claims 1-12 lack a single inventive concept under PCT Rule 13.1.

In fact, claims 1-11 each comprise the currently claimed novel and inventive monocyclopentadienyl complex, in part or in full. Accordingly, Applicant respectfully believes claims 1-11 satisfy PCT Rule 13.1 and 13.2.

Additionally, Applicant respectfully traverses the Examiner's contention that,

. . . (i) Groups I, Groups II&III, Groups IV, and Groups V do not share a common technical feature; (ii) the metallocene catalyst common feature share between Group II and Group III is disclosed in Ewen et al (WO 98/22486). As the recited catalyst complex does not make a contribution over the prior art, i.e. the special technical feature(s) is anticipated by or obvious in view of the prior art, unity of invention is lacking and restriction is appropriate.

In particular, Applicant traverses the Examiner's blanket statement that the recited catalyst complex does not make a contribution over the prior art, and is anticipated by, or alternatively, rendered obvious in view of WO 98/22486 (herein referred to as "Ewen, et al."). Applicant respectfully believes the Examiner has not clearly articulated the basis for the conclusion that claims 7, 8, and 10 (i.e., Groups II and III) are

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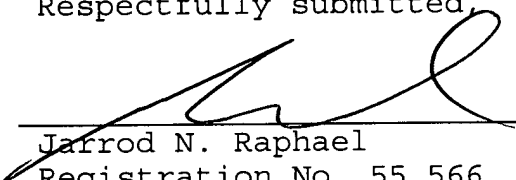
anticipated by, or alternatively rendered obvious in view of Ewen, et al., since the pertinence of Ewen, et al. has not been clearly explained by the Examiner such that Ewen, et al. would anticipate or render obvious the aforementioned claims under 35 U.S.C. §102 or 35 U.S.C. §103. See MPEP §706, §706.02(j), and 37 C.F.R. §1.104.

In view of the foregoing, Applicant respectfully requests the Examiner to reconsider and withdraw the restriction requirement, and to examine all of the claims pending in this application.

If the Examiner has any questions or comments regarding this matter, she is welcomed to contact the undersigned practitioner at the number and address below.

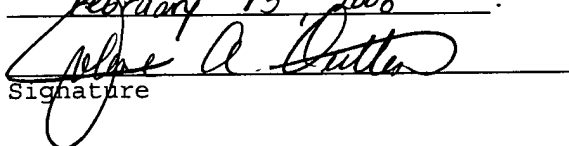
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on

February 13, 2008

Signature

February 13, 2008
Date